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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,487	03/02/2004	Alan Franklin	74119-004	1879
29493 7590 12/22/2006 HUSCH & EPPENBERGER, LLC 190 CARONDELET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441			EXAMINER WITCZAK, CATHERINE	
			ART UNIT	PAPER NUMBER
			3767	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/791,487	Applicant(s) FRANKLIN, ALAN	
	Examiner Catherine N. Witczak	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Witczak 12/15/06

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4, 6, 8, 10, 11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yaacobi (US 6,416,777).

Claims 1, 4, 8, 10, 11, and 15: Yaacobi discloses in Figures 9 and 10 a trans-scleral device attaching to the scleral surface comprising an insert stabilizer (50) having an interlock opening (20) a removeable and refillable implant (46) having a reservoir (81), an interlock tab (87), and an anti-angiogenesis factor in the form of a pellet (column 6, lines 10-23) in the reservoir (81) (column 7, lines 1-27).

Claim 6: Yaacobi discloses in column 8, lines 59-63 refilling the device by disengaging the replaceable implant while leaving the stabilizer attached.

Claim 16: Yaacobi discloses in Figure 9 the stabilizer (50) having a first end in which the interlock opening (20) is disposed, and a second end (25) having a relatively narrower width the first end.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi as modified by Sponsel et al (US 2004/0198829).

Yaacobi discloses in Figures 9 and 10 a trans-scleral device attaching to the scleral surface comprising an insert stabilizer (12) having an interlock opening (20) a removeable and refillable implant (46) having a reservoir (81), an interlock tab (87), and an anti-angiogenesis factor in the form of a pellet (column 6, lines 10-23) in the reservoir (81) (column 7, lines 1-27). Yaacobi further discloses in column 8, lines 59-63 refilling the device by disengaging the replaceable implant while leaving the stabilizer attached.

Yaacobi discloses the claimed invention except for the use of trans-scleral administration of CAI for angiogenesis treatment. Sponsel et al teach that known to use administer CAI trans-sclerally in paragraphs 0112 and 163 to provide an effective way of administering a beneficial anti-angiogenesis factor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Yaacobi with trans-scleral administration of CAI as taught by Sponsel et al, since such a modification would provide the method with an effective way with administering a beneficial anti-angiogenesis factor.

3. Claims 3, 5, 7, 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi as modified by Sponsel et al, and further in view of De Carvalho (US 2005/0113806).



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Yaacobi as modified by Sponsel et al discloses the claimed invention except for the reservoir being refillable through being connected to an injection port and an insert stabilizer comprising an eyelet for attaching the device through suturing. De Carvalho teaches that it is known to use a refillable reservoir connected to an injection port and an insert stabilizer comprising an eyelet for attaching the device through suturing as set forth in Figures 5 and 6 in order to allow safe refill of the reservoir (paragraph 0073) and for attachment of the device to the eye. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Yaacobi and modified by Sponsel et al with a refillable reservoir connected to an injecting port as taught by De Carvalho, since such a modification would provide the method with a way of safely refilling the reservoir and an eyelet for attachment of the device to the eye.

Allowable Subject Matter

Claims 12-14 are allowed.

Response to Arguments

Applicant's arguments filed 10/4/2006 have been fully considered but they are not persuasive. Applicant argues that the Yaacobi device is a one-piece design that cannot be refilled. Although Yaacobi may not teach replacing the insert when the device is implanted, when the device is removed, Yaacobi does disclose that the insert can be separated from the device (see Figures 9 and 10). Therefore, those independent claims which do not positively recite that the insert is removable and refillable when the device is attached to the scleral surface and only recite the insert being removeable from the device in general fall within the scope of Yaacobi's teachings.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine N. Witczak whose telephone number is (571) 272-7179. The examiner can normally be reached on Monday through Friday, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

cw

 12/15/01